
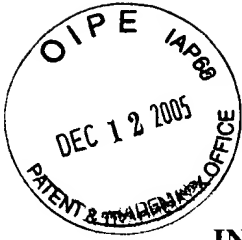


Modified PTO/SB/33 (10-05)

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number | |
|---|----------------------|----------------|--|
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed | |
| | 09/853,634 | March 14, 2001 | |
| | First Named Inventor | | |
| | Masaaki NISHINO | | |
| | Art Unit | Examiner | |
| | 2672 | Javid A. Amini | |
| WASHINGTON OFFICE 23373 CUSTOMER NUMBER | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>50,245</u></p> <div style="text-align: right;"> _____ Signature</div> <div style="text-align: right;"> _____ Brian K. Shelton Typed or printed name</div> <div style="text-align: right;"> _____ (202) 293-7060 Telephone number</div> <div style="text-align: right;"> _____ December 12, 2005 Date</div> | | | |



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64483

Masaaki NISHINO

Appln. No.: 09/853,634

Group Art Unit: 2672

Confirmation No.: 7274

Examiner: Javid A. Amini

Filed: March 14, 2001

For: INFORMATION DISPLAYING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 24, 2005, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

As of the Final Rejection dated January 24, 2005, claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Herbert (U.S. Patent No. 6,014,125) in view of Ahmed et al. (U.S. Patent No. 6,774,912, hereinafter "Ahmed"). Further, claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. For the reasons discussed below, Applicant submits that these rejections are improper, and reversal of the outstanding rejections is requested.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application Serial No. 09/853,634

Attorney Docket No. Q64483

With respect to the rejection of claims 1-8 under 35 U.S.C. § 103(a), Applicant submits that the rejection of these claims is improper at least because the Declaration Under 37 C.F.R. § 1.131 submitted with the Applicant's Response, filed July 22, 2005, establishes conception of the claimed subject matter prior to the effective date of Ahmed and diligence leading to constructive reduction to practice of the claimed invention. As evidenced by the following, the Examiner's determination of insufficiency of the Declaration Under 37 C.F.R. § 1.131 in the Advisory Action of November 29, 2005 is in error.

In the Declaration Under 37 C.F.R. § 1.131, Applicant provided an English translation of the Notification of Employee's Invention and Assignment (Exhibit "B"), which was prepared prior to the effective date of Ahmed, that fully supports the claimed subject matter. Applicant submits that the Declaration clearly contains facts showing a completion of the invention commensurate with the extent of the invention as claimed.

For instance, the Examiner initially points to alleged discrepancies between the figures provided in Exhibit "A" of the Declaration, which is the Japanese language version of the Notification of Employee's Invention and Assignment, and the drawings filed in the present application. However, the Examiner has failed to provide any explanation as to how these supposed distinctions in the drawings establish that support for any claim element is lacking. Likewise, the allegation that Figure 3 of Exhibit "A" "misses" the D/A converter and the analog display does not establish that support for any claim limitation is inadequate, as these elements are clearly shown in Figure 2 and described in the Declaration by Exhibit "B" at pages 1-3.

PRE-APPEAL BRIEF REQUEST FOR REVIEW
Application Serial No. 09/853,634
Attorney Docket No. Q64483

Indeed, Applicant notes that these elements are depicted in Figure 1 of Exhibit “A”, which illustrates an alternate embodiment of the information displaying system, and supporting description of the D/A converter and the analog display can be found at least at pages 1-3 of Exhibit “B”.

Also, Applicant notes that the Examiner apparently contends that the feature of the “digital information data are displayed without overlap at outsides of a displaying region” is not supported by the Declaration because Exhibit “B” discloses that information data are displayed “without spoiling the information in the working region.” The Examiner proceeds to allege that the term “spoiling” is “not *similar* to the term used in the claim as ‘overlap’”. *See* Advisory Action dated November 29, 2005 (emphasis added).

However, the mere fact that different words may be used in the claims versus the disclosure document is an inadequate basis to determine that the support in the Declaration Under 37 C.F.R. § 1.131 is insufficient. Indeed, it is well settled that claim terminology need not correspond *in haec verba* to the language of the disclosure, nor is identical disclosure of the claimed subject matter necessary. Rather, the issue is whether the affidavit contains facts showing a completion of the invention commensurate with the invention as claimed. *See In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). Thus, taken alone, the alleged distinction between the term “without spoiling” and “without overlap” does not establish a lack of support for the claimed subject matter.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application Serial No. 09/853,634

Attorney Docket No. Q64483

Further, the Examiner alleges that the disclosure in Exhibit “B” of additional information data being displayed in regions outside the working region is “not considered consistent” with the recitation of a displaying region being “at an edge” of the displaying means. *See* Advisory Action dated November 29, 2005. However, page 2 of Exhibit “B” describes the operation of an image mixing device in which a scaler writes digital RGB signals and digital information data into respective frame memories and creates display data, and the size of both the RGB signals and the digital information data are determined. Further, Exhibit “B” describes the operation of an image mixing device of the information display system in which scaling is performed on digital RGB signals and digital information data and the digital information data is output in data regions 42, 43, 44 and 45 outside the working region 41 where the digital RGB signals are displayed. *See* Exhibit “B” at page 2. Additionally, the scaling of the RGB signals is described in terms of providing a smaller resolution within the “working region”, while displaying the same amount of information in addition to the information data outside the working region. *See* Exhibit “B” at page 3.

Applicant submits that *at least* this description of the processing and display of digital information data and RGB data and the corresponding illustration of the data regions and working regions provided in Figures 3 and 4 fully support the features of displaying digital information data without overlap at outsides of a displaying region, as claimed. Likewise, the disclosure provided in Exhibit “B” and the illustration of the working regions and data regions

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application Serial No. 09/853,634

Attorney Docket No. Q64483

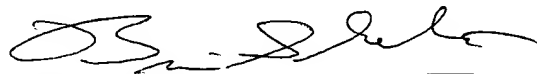
plainly identified in Figures 3 and 4 of Exhibit "A" support the regions for displaying the digital information being at an edge of the displaying means, as defined by claim 1.

In view of the foregoing, Applicant submits that the Examiner has failed to demonstrate that the claimed subject matter is not adequately supported by the evidence provided in the Declaration Under 37 C.F.R. § 1.131. As a result, Applicant submits that the rejection of claims 1-8 under 35 U.S.C. § 103(a) is improper at least because Ahmed reference is removed from the rejection and the Examiner has conceded that Herbert fails to teach all the claim limitations.

With respect to the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, Applicant submits that this ground of rejection is improper for the reasons discussed in Response of July 22, 2005 at pages 3-4.

Accordingly, reversal of the outstanding rejections is respectfully requested.

Respectfully submitted,



Brian K. Shelton

Registration No. 50,245

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 12, 2005